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| 09/871,605 | 06/01/2001 | Akihiro Teramachi | 010713 | 8594 |
| 38834 | 7590 | 11/29/2005 | EXAMINER | |
| WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036 | | | CHOI, PETER H | |
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| | | | 3623 | |

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/871,605 | Applicant(s) TERAMACHI, AKIHIRO | |
| | Examiner Peter Choi | Art Unit 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1,3-7 and 9-12 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This **FINAL** Office Action is responsive to Applicant's amendment filed 9/8/05. Applicant has amended the specification, claims 1, 4 and 7, and canceled claims 2 and 8. Claims 1, 3-7, and 9-12 are pending in the application.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Drawings

3. The previous objection to the drawings made in the Office Action dated June 15, 2005 is withdrawn in view of the applicant's amendment to the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Eisenhart (PGPub 2001/0047276).

As per claim 1, Eisenhart teaches an open research and development method comprising the steps of:

sending membership solicitation information (**registration data**) to a communications network (**using Internet 100**) from a predetermined server (**at a web-based presentation interface on a pedestrian web site**) [Paragraphs 12 and 31];

causing an applicant for membership to report predetermined items (**registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address**) from a network terminal (**computer**) operated by the applicant, by way of the communications network (**using Internet 100**) [Paragraphs 12 and 105];

performing examination operation (**verification of qualifications**) on the reported information (**registration data, contact information**) in connection with membership registration [Paragraphs 12, 45 and 105];

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registering the **(identification)** information about the applicant into a membership database **(database 340) (as a member or personal profile)** on at least the condition that the applicant should have passed the examination operation **(user is a member)** [Paragraphs 13, 45, 46];

selecting members for which provision of information is to be requested **(establishing a need profile)**, by utilization of information about the members **(member profile and need profile of member)** registered in the membership database [Paragraph 14]; then

requesting the selected members **(request direct contact with the business partner to advance the evaluation)** to offer engineering information **(confidential data such as technical documents, test results, and empirical studies)** by way of the communications network [Paragraphs 14 and 33]; and

accumulating, into a knowledge database **(collection of resources {editorial content, templates, tools, links, discussion forums, etc.} into a digital library)** , information which has been transmitted from members **(member profile listings)** registered in the membership database by way of the communications network in relation to a specific topic **(organized by topic, type of deal sought, targeted industry segment)** [Paragraphs 52, 54].

As per claim 3, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

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submitting given inquiries to the applicant (**request for registration data**) by way of the communications network (**Internet 100**) [Paragraphs 12 and 31]; and determining whether to register the applicant as a member (**qualifying the potential member**), on the basis of answers provided (**registration data and contact information**) in response to the inquiries [Paragraphs 12 and 45].

As per claim 4, Eisenhart teaches the open research and development method according to claim 1 or claim 3, wherein the items to be reported by the applicant include items to be used for grasping the applicant's experience (**personal work history**) in research and development [Paragraph 13].

As per claim 6, Eisenhart teaches the open research and development method according to claim 1, wherein the communications network corresponds to the Internet (**Internet 100**), and the membership solicitation information (**registration data**) is sent from a WWW server via the Internet (**community web site 320 using Internet 100**) [Paragraphs 12, 31 and 42].

As per claim 7, Eisenhart teaches an open research and development system comprising:

means (**Internet 100, mail server 301, pedestrian website 310, and private mail server 350**) for sending membership solicitation information (**registration data**) to

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a communications network **(through the pedestrian web site)** [Paragraphs 12, 31, 38 and 41];

means **(Internet 100, mail server 301, pedestrian website 310 and private mail server 350)** for sending items **(registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address)** to be reported at time of application for membership to a network terminal **(computer)** operated by an applicant, by way of the communications network **(Internet 100)** [Paragraphs 12, 38, 41, and 105];

means for acquiring the items **(registration component 321 receives registration and identification data)** which are transmitted from the network terminal by way of the communications network **(Internet 100)** and for performing an examination **(verification of qualifications by qualification component 322)** in connection with membership registration on the basis of the received information **(registration data, contact information)** [Paragraphs 12, 45 and 105];

means for registering **(registration component 321)** the **(identification)** information about the applicant into a membership database **(database 340)** **(as a member or personal profile)** at least on condition that the applicant has passed the examination **(user is a member)** [Paragraphs 13, 45, 46];

means **(Screening and match-making component 440)** for selecting members for which provision of information **(establishing a need profile)** is to be requested, by utilization of information about the members **(member profile and need profile of member)** registered in the membership database [Paragraphs 14 and 55]; and

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means **(Communication manager 326 to send and receive electronic mail messages)** for then requesting the selected members **(request direct contact with the business partner to advance the evaluation)** to offer engineering information **(confidential data such as technical documents, test results, and empirical studies)** by way of the communications network [Paragraphs 14, 33 and 48]; and

means **(Collaboration Manager 325 containing Directory browsing component 430 and Custom feed component 410)** for accumulating, into knowledge database **(collection of resources {editorial content, templates, tools, links, discussion forums, etc.} into a digital library)**, information which pertains to a certain topic **(organized by topic, type of deal sought, targeted industry segment)** and which has been sent from a member registered in the membership database **(member with member profile listed)** by way of the communications network **(Internet 100)**.
[Paragraphs 51-52,54-55]

As per claim 9, Eisenhart teaches the open research and development system according to claim 7, wherein the means for sending items **(Internet 100, mail server 301, pedestrian website 310, and private mail server 350)** to be reported at the time of application for membership submits given inquiries **(request for registration data)** to the applicant by way of the communications network **(Internet 100)** [Paragraphs 12 and 31, 38 and 41]; and the means for performing an examination **(verification of qualifications by qualification component 322)** performs an examination **(qualifying**

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the potential member) on the basis of answers provided **(registration data and contact information)** in response to the inquiries [Paragraphs 12, 45 and 105].

As per claim 10, Eisenhart teaches the open research and development system according to claim 7, wherein the items to be reported for application by the applicant includes items to be used for grasping the applicant's experience **(personal work history)** in research and development [Paragraph 13].

As per claim 12, Eisenhart teaches the open research and development system according to claim 7, wherein the communications network corresponds to the Internet **(Internet 100)**, and the membership solicitation information **(registration data)** is sent from a WWW server via the Internet **(community web site 320 using Internet 100)** [Paragraphs 12, 31 and 42].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenhart.

As per claim 5, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

concluding a secrecy memorandum (**exclusive review agreement and nondisclosure agreement**) with the applicant who has passed the examination operation (**member**) [Paragraphs 15 and 90]

Eisenhart teaches a digital notarization of key documents (such as exclusive review agreements). Official Notice is taken that it is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of using the Internet to conclude a secrecy memorandum between users as a efficient, low-cost means of ensuring that both parties have received certified notarized copies of the exclusive review agreement.

Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum. However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration

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is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

As per claim 11, Eisenhart teaches the open research and development system according to claim 7, further comprising:

means **(Secure collaboration manager 331 and Contract manager 530)** for submitting a secrecy memorandum **(exclusive review agreement and nondisclosure agreement)** to the applicant who has passed the examination operation **(member)**, by way of the communications network [Paragraphs 15, 84 and 90]; and

means **(Deal tracker component 450, which contains acceptance component 458)** for determining whether or not the involved parties have agreed on the secrecy memorandum **(when a supplier and either a buyer or contributor reach an agreement during the course of the negotiation of a notarized document of an exclusive review agreement)** on the basis of the information transmitted from the network terminal in response to the submitted secrecy memorandum [Paragraphs 63, 83-86] .

As cited above, Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum. However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

Response to Arguments

8. Applicant's arguments filed 9/8/05 have been fully considered but they are not persuasive.

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It is noted that the Applicant did not challenge the Official Notice cited in the first Office Action mailed June 15, 2005; therefore, those statements are presented herein as prior art.

Specifically, it is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.).

The Applicant argues that the system of the Eisenhart reference does not request additional information *after* the system has already performed a preliminary selection among the general database of members.

The Examiner respectfully disagrees. The Eisenhart system enables potential members to submit pre-determined registration data to the system at a web-based presentation interface on a pedestrian web site. The system verifies the registration data to qualify the potential member, creating an account for qualified members. Member identification information is stored within a database, implying that said member has obtained membership after passing the verification step. By browsing a directory listing of member profiles, the system uses member and need profiles to recommend other members who have been identified to be a good match (as a potential business partner). A list of good matches is provided, and the member can

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request direct contact with the business partner to advance the evaluation. By requesting direct contact with a specific member to advance the evaluation and exchange information, the member has performed the step of selecting a member from a list of potential partners. The step of generating a list of good matches for potential business partners (based on member and need profiles) occurs prior to the step of requesting direct contact with one of said good matches in order to advance the evaluation.

The Applicant further argues that the applicant's invention includes a method in which members are selected before asking those members to provide information.

The Examiner respectfully disagrees, submitting that a member must inherently be selected prior to the step of requesting additional information from said member, and is already taught by Eisenhart.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker et al. (U.S Patent #5,862,223) teaches an expert matching method for managing communications between an expert having particular qualifications and an


end user seeking a solution to an expert request. The candidate experts submit detailed applications, whose qualifications are authenticated. Once an expert is accepted, he is added to the expert database. An expert may be permitted to intentionally withhold their identity by providing full and partial anonymity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 21, 2005



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600